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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,006	03/28/2002	Alexander Pilger	1454.1124	7148

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EXAMINER

AVELLINO, JOSEPH E

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/018,006	Applicant(s) PILGER ET AL.	
	Examiner Joseph E. Avellino	Art Unit 2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/14/01</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
6) <input type="checkbox"/> Other: _____. |
|--|--|

DETAILED ACTION

1. Claims 7-15 are presented for examination; claim 7 independent. The Office acknowledges the cancellation of claims 1-6 from PCT application.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Regarding claim 12, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 7-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellington, Jr. et al. (USPN 6,175,569) (hereinafter Ellington).

7. Referring to claim 7, Ellington discloses a communication system utilizing a network (Figure 1), comprising:

a first computer (i.e. originating LAN station) connected (the Office takes the term "connected" to mean logically connected, such as a computer behind a firewall in a LAN, since it is still able to connect to other computers on the ATM network, it is considered connected to the network) to the network 10 (Figure 1) including an access unit (incorporated into the originating LAN station) used to determine predetermined QoS features for interaction with the network (col. 5, lines 57-60); and

a second computer (i.e. LAN/ATM Interface Device) connected to the network 10 (Figure 1), to administer to the QoS features of the access unit (col. 6, line 66 to col. 7, line 12).

8. Referring to claim 8, Ellington discloses the network is the Internet (the Internet is a connection of interconnected networks able to allow various LAN's to communicate with one another, such functionality is found in the ATM network 10 since it connects the different LAN networks 18,24 (Figure 1) together (Figure 1, ref. 10).

9. Referring to claim 9, Ellington discloses the access unit is an autonomous device (i.e. it is a originating LAN station, which is considered an autonomous device since it creates QoS parameters independent of any other computing equipment (col. 5, lines 57-60; Figure 1, col. 4, lines 45-62).

10. Referring to claim 10, Ellington discloses the access unit is a plug-in device for the first computer (the Office takes the term "plug-in device" to be broadly construed as "a device which can be connected to a computer" such as the LAN NIC (Network Interface Card) inherently inserted to the LAN station, without this LAN NIC, the computer would not be able to communicate with the network (col. 5, lines 57-60; Figure 1, col. 4, lines 45-62).

11. Referring to claim 11, Ellington discloses the access unit is a processor of the first computer programmed to determine predetermined QoS features for interaction with the network (col. 5, lines 57-60).

12. Referring to claim 12 and 13, it is inherent that the second computer of Ellington (i.e. LAN/ATM Interface Device 12, Figure 1) is assigned to an Internet service provider since it provides service to the LAN 18 since without being assigned as a service provider, the device 12 would not be able to provide service to the LAN.

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13. Referring to claim 14, Ellington discloses the QoS features are called up dynamically in the access unit (the Office takes the term "called up" as created) (col. 5, lines 56-67).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellington.

16. Ellington discloses the invention substantively as described in claim 7. Ellington does not specifically state that converting between a first protocol and a second protocol is effected in the access unit. However since it is inherent that there must be a plug-in NIC for the LAN (see rejection for claim 10) there must be a protocol conversion between the internal bus communication logic (in common PC's it is the PCI protocol) to the protocol of the LAN (in Ellington's case, Token Ring). By this rationale it would be obvious to one of ordinary skill in the art to assume the conversion between PCI and Token Ring is effected by the access unit since it will allow the computer to access the LAN.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

18. Sokol (USPN 6,816,508) discloses mapping a service attribute pertaining to a connection oriented communications network to a connectionless network.

19. Karol et al. (USPN 6,628,617) discloses Internetworking traffic on connectionless and connection-oriented networks.

20. Allan et al. (USPN 6,788,696) discloses transparent QoS using VC-merge capable access modules.

21. Alexander, Jr. et al. (USPN 5,946,311) discloses allowing more efficient communication in an environment wherein multiple protocols are utilized.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JEA

February 2, 2005

Will C. Vaup
Primary Examiner
Art Unit 2143
William C. Vaughn Jr.